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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,497	09/24/2001	Hideyuki Takahashi	010696	2772

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EXAMINER

HUYNH, LOUIS K

ART UNIT PAPER NUMBER

3721

DATE MAILED: 08/19/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,497

Applicant(s)

TAKAHASHI ET AL.

Examiner

Louis K. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-5, 10 and 11, in Paper No. 7 is acknowledged.

Claims 6-9 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 7.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 4-5: "in a corresponding manner" is indefinite for it is unclear as to the arrangement of hoppers with respect to the tablet cases.

Claim 1, line 8: "for charging them" is indefinite for it is unclear as to what "them" is.

Claim 1 is in complete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the holding units (61). Note that the medications received in the hoppers are not charged directly into a predetermined container, they are charged and temporarily retained in a holding cell (21) of a predetermined holding unit (61) prior to being guided and charged into a container by a chute (6). The

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examiner considers the chute (6) to be the claimed charging means because the chute (6) performs the function of guiding and charging the medications into a container (V).

Claim 4, lines 4-5: “in a corresponding manner” is indefinite for it is unclear as to the arrangement of hoppers with respect to the tablet cases.

Claim 4, line 8: “for charging them” is indefinite for it is unclear as to what “them” is.

Claim 4 is in complete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the holding units (61). Note that the medications received in the hoppers are not charged directly into a predetermined container, they are charged and temporarily retained in a holding cell (21) of a predetermined holding unit (61) prior to being guided and charged into a container by a chute (6). The examiner considers the chute (6) to be the claimed charging means because the chute (6) performs the function of guiding and charging the medications into a container (V).

Claim 5, line 4: “in a corresponding manner” is indefinite for it is unclear as to the arrangement of hoppers with respect to the tablet cases.

Claim 5, line 8: “for charging them” is indefinite for it is unclear as to what “them” is.

Claim 5 is in complete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the holding units (61). Note that the medications received in the hoppers are not charged directly into a predetermined container, they are charged and temporarily retained in a holding cell (21) of a predetermined holding unit (61) prior to being guided and charged into a container by a chute (6). The examiner considers the chute (6) to be the claimed charging means because the chute (6) performs the function of guiding and charging the medications into a container (V).

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Claim 10, line 2: "the shutter driving means" lacks proper antecedent basis.

Claim 10, lines 2-3: "the shutter" lacks proper antecedent basis.

Claim 10, lines 3-4: "the rotating motion of the holding unit" lacks proper antecedent basis.

Claim 10, line 4: "the holding unit" lacks proper antecedent basis.

Claim 10, lines 4-5: "the rotation of the rotating plate" lacks proper antecedent basis.

Claim 10, lines 4-5: "the rotating plate" lacks proper antecedent basis.

Claim 10, lines 5-6: "the shutter of the holding unit" lacks proper antecedent basis.

Claim 11, line 3: "the shutters" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1, 2, 4, 5 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaoka et al. (US 6,208,911).

Yamaoka discloses a drug filling apparatus including a plurality of tablet cases (7), a plurality of hoppers (22) disposed under the tablet cases for receiving medications from the tablet cases; each of the hoppers having a dispensing port (23); and a shoot (6) for guiding and charging medications dispensed through the dispensing ports of the hoppers into a container.

With respect to claim 1, the apparatus of Yamaoka includes a retaining member (the mounting plate above the motor 16M; Figure 7) on which the hopper is mounted; wherein the hopper is detachably installed via fastening screws (Figure 7).

With respect to claim 2, Yamaoka discloses a position detector (41) for detecting the position of the hoppers which is considered to be the claimed hopper detecting means because it performs the function of detecting the presence of the hoppers.

With respect to claim 4, the apparatus of Yamaoka includes a plurality of vertical walls (21) for partitioning the hoppers.

With respect to claim 5, each of the hoppers (22) includes anti-spilling wall (19) extending outward from the dispensing port (23).

With respect to claim 10, as best understood, the apparatus of Yamaoka includes a shutter (17), shutter drive means (27) for opening and closing the shutters.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al. (US 6,208,911).

With respect to claim 3, the apparatus of Yamaoka meets all of applicant's claimed subject matter but lacks the specific teaching of a mechanism for adjusting the height of the dispensing port of each hopper. However, the height of hoppers (22) and/or dispensing ports must be adjustable because the hoppers are mounted to rotate above a base plate (24) at a predetermined height in order to retain medication in the hoppers prior to being dispensed into the shoot (6) (column 5, line 62 – column 6, line 2); therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the apparatus of Yamaoka by having provided a mechanism for adjusting the height of the hoppers/dispensing ports to a desired height above the base plate so that the medication could be properly retained in the hoppers.

With respect to claim 11, the apparatus of Yamaoka meets all of applicant's claimed subject matter but lacks the specific teaching of a shutter opening/closing detecting means for detecting the opening and closing of the shutter. However, the apparatus of Yamaoka is controlled by a personal computer via a microprocessor (45) which controls the opening and closing of the shutter (17) and the state of the shutter must be known at all time by the microprocessor so that the microprocessor can operate the shutter properly. Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the apparatus of Yamaoka by having provided a detecting means for

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detecting the opening and closing of the shutter so that the state of the shutter is known to the microprocessor at all time.

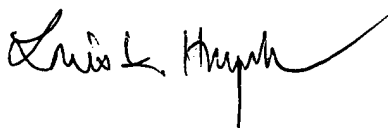
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure has been cited on form PTO-892 along with the applied prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (703) 306-5694. The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703) 308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Louis K. Huynh
Patent Examiner
Art Unit 3721

LH
August 13, 2003